

REMARKS

Prior to entry of this amendment, Claims 1-29 were pending. By this paper, Claims 1, 14, and 19-25 have been amended. Thus, Claims 1-29 remain pending and are presented for further consideration.

Discussion of Claim Rejection under 35 U.S.C. § 101

In section 2 of the Office Action, Claims 1, 19, and 25 are rejected as indefinite under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant respectfully disagrees with the rejection of these claims under 35 U.S.C. §101. In particular, Applicant asserts that an "apparatus" and a "system," as recited in Claims 1 and 25, respectively, are squarely within the bounds of at least one of the four enumerated categories of patentable subject matter recited in section 101 (e.g., a "machine"). Furthermore, Applicant respectfully asserts that Claim 19, which includes means plus function elements, is directed toward statutory subject matter as recited in 35 U.S.C. § 101. As noted in 35 U.S.C. paragraph 6 with reference to means plus function elements, "such claim shall be construed to cover the corresponding *structure, material, or acts* described in the specification and equivalents thereof." Thus, by statute, these means plus function elements are to be construed to cover statutory subject matter in the form of a "structure, material, or acts." Accordingly, Applicant respectfully disagrees with the rejection of Claims 1, 19, and 25.

While Applicant believes that the rejections under 35 U.S.C. § 101 are improper, in order to expedite prosecution of this application, Applicant has amended Claims 1, 19, and 25 by this paper to further clarify that each of the claims is directed toward at least one of the enumerated categories of patentable subject matter. Removal of this rejection is respectfully requested.

Discussion of Claim Rejections under 35 U.S.C. § 112, second paragraph

In section 3 of the Office Action, Claims 14 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as "being incomplete for omitting essential steps or elements, such omission amounting to a gap between the steps or elements." Applicant respectfully traverses this rejection. MPEP 2172.01 states that:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention. (Emphasis added).

Applicant respectfully submits that nowhere in the specification or other statements of record does the Applicant indicate that the element of "convert[ing] the stream of video data into stream of data tokens, wherein the stream of data tokens comprise first plurality of data tokens that are associated with video data encoded in the first format and second plurality of data tokens that are associated with video data encoded in the second format," is "essential to the invention" as indicated in the Office Action. As clearly indicated in MPEP 2172.01, the "matter disclosed to be essential to the invention" must be "described in the specification or in other statements of record." However, the Office Action fails to cite any portions of the specification and/or statements of record on which the rejection is based. Accordingly, the Office Action cannot establish even a prima facie rejection.

Applicant respectfully directs the Examiner to paragraphs [0726]-[0727] of the specification (partially reproduced below), which recites embodiments with features similar to those in Claims 14 and 19 and which do not require "convert[ing] the stream of video data into stream of data tokens, wherein the stream of data tokens comprise first plurality of data tokens that are associated with video data encoded in the first format and second plurality of data tokens that are associated with video data encoded in the second format."

[0726] *Another feature* of the present invention is the use of a SEARCH_MODE control token which is used to reconfigure the input to the serial pipeline processor to look at the incoming bit stream. *When the search mode is set*, the Start Code Detector searches only for a specific start code or marker used in any one of the compression standards. ...

[0727] The use of *search mode* in the present invention is convenient in many situations including 1) if a break in the data bit stream occurs; 2) when the user breaks the data bit stream by purposely changing channels, e.g., data arriving, by a cable carrying compressed digital video; or 3) by user activation of fast forward or reverse from a controllable data source

such as an optical disc or video disc. In general, a search mode is convenient when the user interrupts the normal processing of the serial pipeline at a point where the machine does not expect such an interruption. (Emphasis added).

As noted in the specification quote above, the search mode is "another feature" that may be "set," or conversely not set, in order to perform certain features associated with the search mode. However, there are no requirements that the method or system of Claims 14 and 19, respectively, include "convert[ing] the stream of video data into stream of data tokens..." as indicated in the Office Action. Additionally, there is no requirement that a feature recited in one claim element must be repeated in other claims. Furthermore, Applicant respectfully submits that it is irrelevant to the patentability of Claims 14 and 19 what their respective method and system include and/or perform in addition to the recited features of the claims. Rather, the recitation of features in Claims 14 and 19 considered separate from any other features that might be described in the specification, including other claims, are patentable over the cited art. Accordingly, removal of this rejection is respectfully requested.

Other Patents and Patent Applications

This pending patent application is part of a large patent family, thus Applicant wishes to draw the Examiner's attention to the following matters:

Appl. No.	Filing Date	Attorney Docket No.	Title
08/082,291 abandoned	06/24/93	N/A	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD
08/382,958 abandoned	02/02/95	N/A	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD
08/400,397 abandoned	03/07/95	N/A	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD WITH START CODE DETECTOR
08/399,898, now U.S. Patent No. 5,768,561	03/07/1995	KM0920.1CCPD1	TOKENS-BASED ADAPTIVE VIDEO PROCESSING ARRANGEMENT
08/400,211, now U.S. Patent No. 5,842,033	03/07/1995	KM0920.1CCPD3	PADDING APPARATUS FOR PASSING AN ARBITRARY NUMBER OF BITS THROUGH A BUFFER IN A PIPELINE SYSTEM
08/400,201, now U.S. Patent	03/07/1995	KM0920.1CCPD7	START CODE DETECTOR

Appl. No.	Filing Date	Attorney Docket No.	Title
No. 5,603,012 08/483,020, now U.S. Patent No. 6,035,126	06/07/1995	KM0920.1CCPD4	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD
08/484,730, now U.S. Patent No. 6,263,422	06/07/1995	KM0920.1CCPD13	PIPELINE PROCESSING MACHINE WITH INTERACTIVE STAGES OPERABLE IN RESPONSE TO TOKENS AND SYSTEM AND METHODS RELATING THERETO
08/482,296, now U.S. Patent No. 6,435,737	06/07/1995	KM0920.1CCPD8	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD
08/850,125, now U.S. Patent No. 5,956,519	05/01/1997	KM0920.1CCPD6C	PICTURE END TOKEN IN A SYSTEM COMPRISING A PLURALITY OF PIPELINE STAGES
08/903,969, now U.S. Patent No. 6,038,380	07/31/1997	KM0920.1CCPD14C	DATA PIPELINE SYSTEM AND DATA ENCODING METHOD
08/937,143, now U.S. Patent No. 6,079,009	09/24/1997	KM0920.1CCPD15C	CODING STANDARD TOKEN IN A SYSTEM COMPRISING A PLURALITY OF PIPELINE STAGES
08/947,727, now U.S. Patent No. 5,809,270	09/25/1997	KM0920.1CCPD2C	INVERSE QUANTIZER
08/947,675, now U.S. Patent No. 5,881,301	10/02/1997	KM0920.1CCPD12C	INVERSE MODELLER
09/307,239, now U.S. Patent No. 6,330,666	10/07/1997	KM0920.1CCPC1	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION SYSTEM FOR PROCESSING ENCODED BIT STREAMS INCLUDING START CODES AND METHODS RELATING THERETO
08/946,754, now U.S. Patent No. 6,067,417	10/07/1997	KM0920.1CCPD16C	PICTURE START TOKEN
08/947,676, now U.S. Patent No. 5,978,592	10/08/1997	KM0920.1CCPD9C	VIDEO DECOMPRESSION AND DECODING SYSTEM UTILIZING CONTROL AND DATA TOKENS
08/967,515, now U.S. Patent No. 6,112,017	11/11/1997	KM0920.1CCPD10C	PIPELINE PROCESSING MACHINE HAVING A PLURALITY OF RECONFIGURABLE PROCESSING STAGES INTERCONNECTED BY A TWO-WIRE INTERFACE BUS

Appl. No.	Filing Date	Attorney Docket No.	Title
09/770,157	01/26/01	KM0920.1CCPCD1	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION SYSTEM FOR PROCESSING ENCODED BIT STREAMS INCLUDING START CODE DETECTION AND METHODS RELATING THERETO
09/776,641, now U.S. Patent No. 6,950,930	02/05/2001	KM0920.1CCPCD3	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION SYSTEM FOR PROCESSING ENCODED BIT STREAMS INCLUDING PIPELINE PROCESSING AND METHODS RELATING THERETO
09/777,283, now U.S. Patent No. 6,910,125	02/06/2001	KM0920.1CCPCD6	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION SYSTEM FOR PROCESSING ENCODED BIT STREAMS INCLUDING A DECODER WITH TOKEN GENERATOR AND METHODS RELATING THERETO
09/778,377, now U.S. Patent No. 6,697,930	02/07/2001	KM0920.1CCPCD2	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION METHOD FOR PROCESSING ENCODED BIT STREAMS ACCORDING TO RESPECTIVE DIFFERENT STANDARDS
09/974,530, now U.S. Patent No. 7,230,986	10/10/2001	KM0920.1CCPCD4D	MULTISTANDARD VIDEO DECODER AND DECOMPRESSION SYSTEM FOR PROCESSING ENCODED BIT STREAMS INCLUDING A VIDEO FORMATTER AND METHODS RELATING THERETO

Applicant notes that these matters relate, or may relate, to the present application. In addition, these matters include cited references, office actions, responses and notices of allowance. Applicant also notes that there may be other abandoned applications that form part of the patent family.

Applicant understands that the Examiner often has access to sophisticated online Patent Office computing systems that provide ready access to, for example,

specification and drawing publications, pending claims and complete file histories, including, for example, cited art, office actions, responses, and notices of allowance.

Thus, Applicant respectfully requests the Examiner to review these file histories with respect to the patentability of this application. Also, if the Examiner cannot readily access these file histories, Applicant would be pleased to provide any portion of any of the file histories at any time upon specific Examiner request.

Rescission OF Any Prior Disclaimers and Request to Revisit Art

The claims of the present application are different and possibly broader in scope than any pending claims in any related application or issued claims in any related patent.

In these related cases, claims have been amended and received allowance over a number of references. To the extent that any amendments or characterizations of the scope of any claim or referenced art could be construed as a disclaimer of any subject matter supported by the present disclosure, Applicant hereby rescinds and retracts such disclaimer. Accordingly, the references cited in the related applications may need to be re-visited.

Also, the present communication includes alterations to the claims and to the extent claim scope or referenced art has been characterized, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application.

Applicants also reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution.

In addition, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Conclusion


In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/15/2009

By: 
Russell M. Jeide
Registration No. 54,198
Attorney of Record
Customer No. 20,995
(951) 781-9231

6116615_1
010609